

REMARKS

The Office Action dated November 16, 2005 contained a rejection of claims 1-16. The Applicants have amended independent claims 1, 7, 8, 9, 15, and 16. Claims 1-16 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Howard (U.S. Patent Publication No. 2005/0091109) in view of Applicants' Background of the Invention.

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

Namely, the Applicants' claimed invention recites in part "...automatically tracking publication distribution to various recipient subscribers...determining the subscriber's publication usage levels from data in said user profile and the automatically tracked publication distribution, wherein the data includes historical data on the subscriber's usage of on-line publications..."

In contrast, the combination of Howard with the Applicants' Background of the Invention does **not** disclose all of the Applicants' amended claims. Specifically, **none** of cited references, in combination or alone, disclose the Applicants' newly added automatically tracking publication distribution to various recipient subscribers and using historical data on the subscriber's usage of on-line publications to determine the subscriber's publication usage levels and sending a targeted paid advertisement if the subscriber's usage level is high and sending a targeted content advertisement if the subscriber's usage level is low.

In addition, even though the combined references do not disclose, teach, or suggest the Applicants' newly claimed invention, the Applicants respectfully submit that Howard should not be combined with the Applicants' Background of the Invention. First, although the Applicants' Background of the Invention discloses "...[B]ecause the advertising revenue that a publisher can generate is usually proportional to the number of subscribers that it can demonstrate to prospective advertisers, increasing circulation...remains a top priority...", this statement is a **general** goal or problem that advertisers address on a daily basis. This statement does not provide any specific

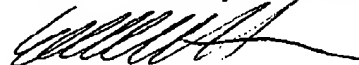
answers or solutions to solve the problem or achieve those goals. Thus, the disclosure of a problem statement or goal to be achieved to render obvious the Applicants' claimed unique distribution solution based on usage levels, which specifically solves the problem or achieves that goal, is improper and is not supported by the patent regulations, case law, and/or the MPEP. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, the **failure** of the cited references, either alone or in combination, to disclose, suggest or provide motivation for the Applicant's claimed invention, indicates a lack of a prima facie case of obviousness, which means the combined cited references cannot render the Applicant's invention obvious. (MPEP 2143).

With regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on at least the same basis. (MPEP § 2143.03).

In view of the arguments and amendments set forth above, the Applicants respectfully submit that the rejected claims are in immediate condition for allowance. The Examiner is therefore respectfully requested to withdraw the outstanding claim rejections and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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